

124



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,131	03/15/2001	Takumi Hasegawa	NEC2120-US	4638

21254 7590 07/15/2004

MCGINN & GIBB, PLLC  
8321 OLD COURTHOUSE ROAD  
SUITE 200  
VIENNA, VA 22182-3817

EXAMINER
----------

KOSOWSKI, ALEXANDER J

ART UNIT	PAPER NUMBER
----------	--------------

2125

DATE MAILED: 07/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary****Application No.**

09/808,131

**Applicant(s)**

HASEGAWA, TAKUMI

**Examiner**

Alexander J Kosowski

**Art Unit**

2125

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 April 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 2125

### DETAILED ACTION

- 1) Claims 1-8 and new claims 9-38 are presented for examination in light of the amendment filed 4/30/04.

#### *Specification*

- 2) The objection to the disclosure from the previous office action is withdrawn in light of the amendment filed 4/30/04.

#### *Claim Objections*

- 3) The claim objections from the previous office action are withdrawn in light of the amendment filed 4/30/04.

#### *Claim Rejections - 35 USC § 102*

- 4) The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 5) Claims 1-2, 5, 7, 13-17, 21-23 and 30-33 are rejected under 35 U.S.C. 102(b) as being unpatentable by Kagawa et al (U.S. Pat 5,687,094).

Referring to claim 1, Kagawa teaches an apparatus with first means for detecting whether a modification to a bug exceeds a pre-established criterion (col. 5 lines 22-39 and col. 8 lines 5-19), and second means for collecting and recording a bug information corresponding to said modification when said first means detects that said modification exceeds said pre-established criterion (col. 5 lines 15-21 and lines 41-56).

Art Unit: 2125

Referring to claim 2, Kagawa teaches that said information includes character information (col. 6 lines 14-44).

Referring to claim 5, the claim varies from claim 1 in that it claims a method rather than an apparatus. The apparatus of claim 1 could inherently be implemented as a series of method steps. Therefore, referring to claim 5, see rejection of claim 1 above.

Referring to claim 7, the claim varies from claim 1 in that it claims a computer program rather than an apparatus. The apparatus of claim 1 could inherently be implemented as a computer program causing a computer to execute a sequential method. Therefore, referring to claim 7, see rejection of claim 1 above.

Referring to claim 13, Kagawa teaches the apparatus according to claim 1, wherein said first means automatically detects whether said modification exceeds said pre-established criterion (col. 5 lines 22-39 and col. 8 lines 5-19).

Referring to claim 14, Kagawa teaches the apparatus according to claim 1, wherein said first means instantaneously detects whether said modification exceeds said pre-established criterion (col. 5 lines 22-39 and col. 8 lines 5-19).

Referring to claim 15, Kagawa teaches the apparatus according to claim 1, wherein said first means detects whether each said modification exceeds said pre-established criterion (col. 5 lines 22-39 and col. 8 lines 5-19).

Referring to claim 16, Kagawa teaches the apparatus according to claim 1, wherein said second means automatically collects and records said bug information (col. 5 lines 15-21 and lines 41-56).

Art Unit: 2125

Referring to claim 17, Kagawa teaches the apparatus according to claim 1, wherein said second means automatically collects and records said bug information for each said modification (col. 5 lines 15-21 and lines 41-56).

Referring to claim 21, Kagawa teaches the method according to claim 5, wherein said detecting comprises automatically detecting whether said modification exceeds said pre-established criterion (col. 5 lines 22-39 and col. 8 lines 5-19).

Referring to claim 22, Kagawa teaches the method according to claim 5, wherein said detecting comprises instantaneously detecting whether said modification exceeds said pre-established criterion (col. 5 lines 22-39 and col. 8 lines 5-19).

Referring to claim 23, Kagawa teaches the bug collection method according to claim 5, wherein said detecting comprises detecting whether each said modification exceeds said pre-established criterion (col. 5 lines 22-39 and col. 8 lines 5-19).

Referring to claim 30, Kagawa teaches the apparatus according to claim 1, wherein said first means detects whether each modification to said bug exceeds a pre-established criterion (col. 5 lines 22-39 and col. 8 lines 5-19).

Referring to claim 31, Kagawa teaches the apparatus according to claim 1, wherein said first means detects whether a plurality of modifications to said bug exceeds a pre-established criterion (col. 5 lines 22-39 and col. 8 lines 5-19).

Referring to claim 32, Kagawa teaches the apparatus according to claim 1, wherein said second means collects and records a bug information corresponding to each modification when said first means detects that said each modification exceeds said pre-established criterion (col. 5 lines 15-21 and lines 41-56).

Referring to claim 33, Kagawa teaches the apparatus according to claim 1, wherein said second means collects and records a bug information corresponding to a plurality of modifications when said first means detects that said plurality of modifications exceeds said pre-established criterion (col. 5 lines 15-21 and lines 41-56).

***Claim Rejections - 35 USC § 103***

6) The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7) Claims 3-4 and 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kagawa, further in view of Miyakawa et al (U.S. Pat 6,223,092).

Referring to claim 3, Kagawa teaches the apparatus above. However, Kagawa does not explicitly teach that said first and second means are provided separately from one another, said apparatus further comprising a third means for sending said bug information from said first means to said second means.

Miyakawa teaches a design evaluation system which utilizes networked databases for collecting and recording information (col. 7 lines 25-52).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to separate the first and second means and send information between them in the invention taught by Kagawa since transmitting data to a remote location for storage is well

Art Unit: 2125

known in the art and would allow the data to be accessed by multiple sources located anywhere on an attached network, which would increase system flexibility.

Referring to claim 4, Kagawa teaches an apparatus comprising first means for detecting whether a modification to a bug exceeds a pre-established criterion (col. 5 lines 22-39 and col. 8 lines 5-19), and second means for collecting and recording a bug information corresponding to said modification when said first means detects that said modification exceeds said pre-established criterion (col. 5 lines 15-21 and lines 41-56). However, Kagawa does not explicitly teach that said first and second means are provided separately from one another, said apparatus further comprising a third means for sending said bug information from said first means to said second means.

Miyakawa teaches a design evaluation system which utilizes networked databases for collecting and recording information (col. 7 lines 25-52).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to separate the first and second means and send information between them in the invention taught by Kagawa since transmitting data to a remote location for storage is well known in the art and would allow the data to be accessed by multiple sources located anywhere on an attached network, which would increase system flexibility.

Referring to claim 6, the claim varies from claim 4 in that it claims a method rather than an apparatus. The apparatus of claim 4 could inherently be implemented as a series of method steps. Therefore, referring to claim 6, see rejection of claim 4 above.

Referring to claim 8, the claim varies from claim 4 in that it claims a computer program rather than an apparatus. The apparatus of claim 4 could inherently be implemented as a

Art Unit: 2125

computer program causing a computer to execute a sequential method. Therefore, referring to claim 8, see rejection of claim 4 above.

8) Claims 9, 11-12, 18-20, 24-29 and 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kagawa, further in view of Yada (U.S. Pat 5,418,728).

Referring to claim 9, Kagawa teaches an apparatus comprising:  
means for automatically determining whether a design modification exceeds  
a predetermined criterion (col. 5 lines 22-39 and col. 8 lines 5-19); and means for automatically  
collecting and recording a bug information corresponding to said modification when said  
modification exceeds said predetermined criterion (col. 5 lines 15-21 and lines 41-56). However,  
Kagawa does not explicitly teach means for detecting whether a design modification is  
generated.

Yada teaches a computer aided design support device which detects whether design  
modifications have been generated in a CAD environment (col. 3 lines 61-67).

Therefore, it would have been obvious to one skilled in the art at the time the invention  
was made to provide means for detecting whether a design modification is generated in the  
apparatus taught by Kagawa since this would increase efficiency in the entire process of design  
in a computer aided design system (Yada, col. 2 lines 36-38).

Referring to claim 11, Kagawa teaches a method comprising:  
determining whether a modification exceeds a predetermined criterion (col. 5 lines 22-39 and  
col. 8 lines 5-19); and collecting a bug information corresponding to said modification when said



Art Unit: 2125

modification exceeds said predetermined criterion (col. 5 lines 15-21 and lines 41-56). However, Kagawa does not explicitly teach detecting a modification to said design.

Yada teaches a computer aided design support device which detects whether design modifications have been generated in a CAD environment (col. 3 lines 61-67).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide means for detecting whether a design modification is generated in the apparatus taught by Kagawa since this would increase efficiency in the entire process of design in a computer aided design system (Yada, col. 2 lines 36-38).

Referring to claim 12, Kagawa teaches sending said bug information corresponding to said modification to a collector for collecting said bug information when said modification exceeds said predetermined criterion, and recording said bug information received by said collector (col. 5 lines 15-21 and lines 41-56).

Referring to claims 18-20, Kagawa teaches the apparatus above. However, Kagawa does not explicitly teach means for detecting said design modification, means for continuously detecting design modifications, nor means for automatically detecting design modifications.

Yada teaches a computer aided design support device which detects whether design modifications have been generated in a CAD environment (col. 3 lines 61-67).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide means for detecting, continuously detecting, and automatically detecting whether a design modification is generated in the apparatus taught by Kagawa since this would increase efficiency in the entire process of design in a computer aided design system (Yada, col. 2 lines 36-38).

Art Unit: 2125

Referring to claim 24, Kagawa teaches the method according to claim 5, wherein said collecting comprises automatically collecting said bug information corresponding to said modification (col. 5 lines 15-21 and lines 41-56). However, Kagawa does not explicitly teach that said information is collected when a modification is detected.

Yada teaches a computer aided design support device which detects whether design modifications have been generated in a CAD environment (col. 3 lines 61-67).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide means for detecting whether a design modification is generated in the apparatus taught by Kagawa since this would increase efficiency in the entire process of design in a computer aided design system (Yada, col. 2 lines 36-38).

Referring to claim 25, Kagawa teaches the method according to claim 5, wherein said collecting comprises automatically collecting said bug information corresponding to each said Modification (col. 5 lines 15-21 and lines 41-56). However, Kagawa does not explicitly teach that said information is collected when a modification is detected.

Yada teaches a computer aided design support device which detects whether design modifications have been generated in a CAD environment (col. 3 lines 61-67).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide means for detecting whether a design modification is generated in the apparatus taught by Kagawa since this would increase efficiency in the entire process of design in a computer aided design system (Yada, col. 2 lines 36-38).

Referring to claims 26-28, see rejection of claims 18-20 above.

Referring to claim 29, Kagawa teaches an apparatus comprising:

Art Unit: 2125

a determiner that automatically determines whether said design modification exceeds a predetermined criterion (col. 5 lines 22-39 and col. 8 lines 5-19); and a collector that automatically collects and records a bug information corresponding to said modification when said modification exceeds said predetermined criterion (col. 5 lines 15-21 and lines 41-56).

However, Kagawa does not explicitly teach a detector that detects whether a design modification is generated.

Yada teaches a computer aided design support device which detects whether design modifications have been generated in a CAD environment (col. 3 lines 61-67).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide means for detecting whether a design modification is generated in the apparatus taught by Kagawa since this would increase efficiency in the entire process of design in a computer aided design system (Yada, col. 2 lines 36-38).

Referring to claim 34, Kagawa teaches the apparatus according to claim 29, wherein said determiner automatically determines, without human intervention, whether said design modification exceeds said predetermined criterion (col. 5 lines 22-39 and col. 8 lines 5-19).

Referring to claim 35, Kagawa teaches the apparatus according to claim 29, wherein said collector automatically collects and records, without human intervention, said bug information corresponding to said modification when said modification exceeds said predetermined criterion (col. 5 lines 22-39 and col. 8 lines 5-19).

Referring to claim 36, Kagawa teaches an apparatus comprising:  
a determiner that automatically determines whether said design modification exceeds a predetermined criterion (col. 5 lines 22-39 and col. 8 lines 5-19), and

Art Unit: 2125

a collector that automatically collects and records a bug information corresponding to said modification when said modification exceeds said predetermined criterion (col. 5 lines 15-21 and lines 41-56). However, Kagawa does not explicitly teach a detector that detects whether a design modification is generated during a design modification process.

Yada teaches a computer aided design support device which detects whether design modifications have been generated in a CAD environment (col. 3 lines 61-67).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide means for detecting whether a design modification is generated during a modification process in the apparatus taught by Kagawa since this would increase efficiency in the entire process of design in a computer aided design system (Yada, col. 2 lines 36-38).

Referring to claims 37-38, Kagawa teaches the apparatus according to claim 36, wherein said determiner automatically determines whether said design modification exceeds a predetermined criterion (col. 5 lines 22-39 and col. 8 lines 5-19). However, Kagawa does not explicitly teach that this determination is made at a time of said design modification or at a time when said design modification is made.

Yada teaches a computer aided design support device which detects whether design modifications have been generated in a CAD environment (col. 3 lines 61-67).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide means for detecting whether a design modification is generated during a modification process and to determine whether said design modification exceeds a

Art Unit: 2125

predetermined criterion in the apparatus taught by Kagawa since this would increase efficiency in the entire process of design in a computer aided design system (Yada, col. 2 lines 36-38).

9) Claims 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kagawa, further in view of Yada, further in view of Miyakawa et al (U.S. Pat 6,223,092).

Referring to claim 10, Kagawa and Yada teach the apparatus above. However, they do not explicitly teach that the means for automatically collecting and recording is provided separately from said means for detecting, and wherein said apparatus further comprises means for sending said bug information from said means for determining to said means for collecting and recording.

Miyakawa teaches a design evaluation system which utilizes networked databases for collecting and recording information (col. 7 lines 25-52).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to provide means for automatically collecting and recording separately from said means for detecting and to provide means for sending said bug information from said means for determining to said means for collecting and recording in the invention above since transmitting data to a remote location for storage is well known in the art and would allow the data to be accessed by multiple sources located anywhere on an attached network, which would increase system flexibility.

### ***Response to Arguments***

10) Referring to arguments regarding claims 1-8, as entered by applicant concurrent with the amendment filed 4/30/04, examiner stands behind his original rejection. Applicant argues that

Art Unit: 2125

the Kagawa reference does not teach a "method for collecting bug information when a design modification is made to a bug in a drawing". However, examiner notes that the terminology used in the claims as currently amended does not necessitate that the information must be collected "automatically" (to further quote applicant's arguments) when a design modification is made. Rather, as currently amended, claims 1-8 continue to read on the Kagawa reference, and therefore remain rejected.

In addition, examiner notes that applicant's arguments are all directed towards the preamble of the associated independent claims. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

### ***Conclusion***

11) **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

Art Unit: 2125

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

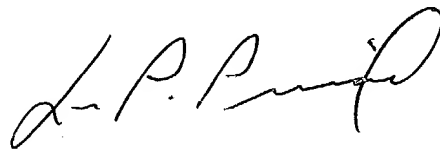
12) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander J Kosowski whose telephone number is 703-305-3958.

The examiner can normally be reached on Monday through Friday, alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard can be reached on 703-308-0538. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. In addition, the examiner's RightFAX number is 703-746-8370.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Alexander J. Kosowski  
Patent Examiner  
Art Unit 2125



LEO PICARD  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100